



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,200	11/06/2001	Albert Dimberger	16616-4	8061

7590

12/13/2002

Clifford W. Browning
Woodard, Emhardt, Naughton, Moriarty & McNett
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/993,200

Applicant(s)
Dirnberger

Examiner
Estremsky

Art Unit
3677



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

Art Unit: 3677

DETAILED ACTION

Claim Objections

1. Claim 37-39 and 41 are objected to because of the following informalities:
 - a. Claim 37 - recitation of "the tensioning lever", "the steering arm" lack clear antecedent basis in the claim.
 - b. Claim 38 - recitation of "the closing lever", "the steering arm" lack clear antecedent basis in the claim.
 - c. Claims 39 and 41 - recitation of "the steering rod" lacks clear antecedent basis in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 3677

The “and/or” limitation, but particularly the exclusive “or” portion of same, defines the invention as having one or the other of “rotatable components” and “contacting surfaces”. While the disclosure is enabling for embodiments having both “rotatable components” and “contacting surfaces”, ‘as best understood’, no embodiment of the invention has been disclosed that does not include both. Accordingly, the original disclosure is not enabling for the scope of this claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Preliminarily, the phrase “such as,...” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Similarly, the body of the claim which generally defines the ‘invention’ is in this case, all contained within description beginning “for example”; which renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. Again, see MPEP § 2173.05(d).

Additionally, use of the “and/or” limitation, in this case renders the scope of the claim indefinite since as best understood, the disclosed invention requires both “rotatable components”

Art Unit: 3677

and “contacting surfaces” whereby the limitation does not seem to accurately define what has been disclosed as the invention.

Regardless, the scope of the functional limitation beginning “constructed in such a manner, that forces required during a transition ,...” renders the scope of the claim indefinite. After reading the specification, it is clear that elements in addition to the “rotatable components” and/or “contacting surfaces” are required in order to achieve the recited function, i.e., springs, etc as a minimum. Due to language and form of the recitation, it cannot be given weight in accordance with 35 USC 112, 6th paragraph. See MPEP 2181-2185. Accordingly, it is not clear if the scope of the claims should include the elements that have been disclosed as required for the ‘capability’.

Applicable to each of the independent claims, no particular structure or arrangement is defined by the functional recitation of the last clause. The scope of structures and arrangements that might be included or required (in addition to the elements that might be claimed) to perform the function is not reasonably determinable since the functional recitation is essentially formed as a ‘result’ when the claimed elements are used with various unclaimed elements in a certain manner of intended use. For example, no “forces” are part of the invention, those forces apparently stemming from intended process of use with unclaimed elements. See MPEP 2173.05 (p), section II as regards product and process of using in the same claim. The scope of the claim cannot be determined.

Art Unit: 3677

Additionally, the language of the claims does not clearly define the invention. It is not clear what is included by limitation that “forces required during a transition from the closed position to the open position essentially correspond to forces required for a transition from the open position to the closed position. Limitation of “correspond to” is vague.

With reference to Fig's 1a,1b for example, it's noted that upon contact of parts 42 and 18 and consequent pressing in of part 18, the user will have to provide a force to overcome spring 16 and cause that inward movement. During that same, but reversely-directed motion during unlatching, the spring 16 will provide a force to push part 42 outwards. Those forces are essentially equal but opposite. It has been assumed for purpose of examination, that is what is intended by vague limitation of “correspond to” but clarification is required inasmuch as that is not clearly stated in the claims.

As best understood, after reading the specification, the functionally-recited ‘result’ of the claims is intended to describe the results of graph 2b (as contrasted with the results of graph 2a). But the examiner notes that lines II and III of graph 2b are not identical and in that respect the difference between that result and the result illustrated in graph 2a is a matter of degree. In this respect, the claims rely upon an unusual interpretation of the term “essentially” inasmuch as the disclosed invention is not capable of achieving ‘forces’ that ‘correspond’ exactly. Consequently the ‘range’ of the invention as claimed, falls entirely within whatever range of force difference might be considered ‘essentially correspond to’ but based upon the disclosed invention can never include exact correspondence. However, since the extent of the range cannot be reasonably

Art Unit: 3677

determined, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. As best understood, claims 21-36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,290,270 to Spiessl.

Spiessl '270 teaches Applicant's claim limitations of "rotatable components" - 12,20, and "contacting surfaces" - contacting portions of 20,26.

It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. At a point just after contact of parts 20,49 during closing, the force required is inherently equal and opposite to the force pushing part 49 away during the opening movement at that position. This equal and opposite

Art Unit: 3677

‘correspondence’ between opening/closing force and latch position is the same throughout the range of movement.

Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

As regards claims 22,23, limitation of “bearings” reads on the relevant load-bearing surfaces of the reference which transmit forces from one part to the next inasmuch as plain limitation of “bearings” is broad and does not require ‘ball bearings’, or ‘roller bearings’, ‘low-friction plastic’, or ‘lubricous metal’ material for example at the bearing points.

As regards claim 24, part 20 reads on “gripping device” and protruding portion of part 26 reads on “contact region” where those elements are essentially the same as corresponding elements disclosed by Applicant but where the examiner notes for the purpose of expediting prosecution, that the claim limitations are much broader.

As regards claim 26, two limitations are phrased in the alternative. As regards the first alternative limitation, part 20 reads on broad limitation of “rotatably mounted axle” with respect to its circumferentially-arranged active region. As regards the second of the alternative limitations, there is alternative interpretation of the reference; i.e., part 20 reads on “bearing” since it receives and transmits forces through the latch mechanism. In that respect, it’s noted that part 20 is “rotatable relative to an axle (22)”.

With respect to either interpretation, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require

Art Unit: 3677

that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it.

Kalman v. Kimberly-Clark Corp., 218 USPQ 789. Since the limitations are phrased in the alternative, if the reference reads on either limitation, it anticipates the claimed invention.

As regards claim 31, the reference discloses a "frame" - including 10 and a "closing lever" - 12.

As regards claim 34, part 12 reads on limitation of "tensioning lever".

8. As best understood, claims 21-25, 27-36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 3,670,537 to Horgan.

Horgan '537 teaches Applicant's claim limitations including : "rotatable components" - including 12,60,100,, and "contacting surfaces" - any of the contacting portions of the parts of the latch read on broad limitation. Forces for locking/unlocking are inherently equal and opposite at any given point in the range of movement.

As regards claim 22, the reference teaches several parts that function as "bearings" including 'ball bearings' for reducing friction.

As regards claim 24, parts including 12,60,132 reads on "gripping device", part 132 reads on "active area" and portions contacted by part 120 read on broad limitation of "contact region".

As regards claim 31, part 60 reads on "closing lever".

Art Unit: 3677

As regards claim 34, part 60 reads on broad limitation of "tensioning lever".

Allowable Subject Matter

9. Claims 37-41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph (particularly by including the elements disclosed for performing the recited function), set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Remarks

10. Except as indicated above, an embodiment of the invention has been disclosed that should enable one of ordinary skill in the art to make and use an embodiment of the invention as claimed. However, some of the written specification's statements about hysteresis have been noted.

As part of the examiner's position, it is pointed out *that neglecting various frictional effects*, the energy stored in a spring (even as arranged in a conventional 'over-center' latch mechanism) during deformation in a first movement of latching for example, is fully recovered when the spring recovers to its original dimension during the reverse movement. That is not say that a latch having a conventional spring latch mechanism may not be easier or harder to latch than it is to unlatch. In that respect, the difference between ease of operation and hysteresis is noted.

Art Unit: 3677

Additionally, it is noted that since even roller bearings, for example, have frictional losses, any differences in latching/unlatching forces of latches having or not having roller bearings, for example, (or other sort of bearing) is a matter of degree at most. In that respect, it does not seem possible that the disclosed latch could operate completely without hysteresis.

These statements are intended to clarify the examiner's position as regards inherent operational characteristics of the prior art and thereby expedite prosecution as much as possible. Inasmuch as the claims have not positively recited the parts of the device that have been disclosed for achieving the 'result' functionally recited in the claim and since that result is broadly and indefinitely stated in the claims, the product claimed as the invention has no particular structure which can be relied upon to patentably define from the prior art. Since limitation of 'bearing' must be interpreted consistent with its broadest reasonable interpretation, this feature has not patentably defined from the prior art.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Pat. No. 2,138,251 to Lindstrom.
- b. U.S. Pat. No. 2,833,578 to Burke.
- c. U.S. Pat. No. 3,328,062 to Geiger.
- d. U.S. Pat. No. 4,497,513 to Saski.

Art Unit: 3677

e. U.S. Pat. No. 5,440,103 to Martin.

f. U.S. Pat. No. 6,048,001 to Miller.

12. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or

- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do

Art Unit: 3677

not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

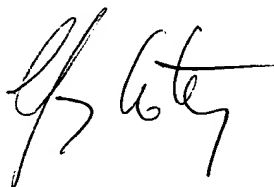
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.
- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

December 9, 2002



GARY ESTREMSKY
PRIMARY EXAMINER